

B4
a first tab comprising a plurality of hooks of a hook and loop-type fastener appended to said foot wrap for wrapping around the arch of a human foot for releasably securing said foot wrap to the human foot with the bladder positioned so as to act directly against the sole of the foot when the hooks contact the outer surface of said foot wrap; and

an elongate second tab comprising a plurality of hooks of a hook and loop-type fastener appended to said foot wrap for releasably wrapping around the heel and releasably securing to the outside surface of said foot wrap for maintaining the position of the bladder against the sole of the foot.

REMARKS

In the Official Action of October 29, 2002, the rejections made in the first Official Action were withdrawn. However, claims 1-8 and 13 were rejected under 35 U.S.C. 103 as unpatentable over Kartheus, *et al.* in view of Dye and claims 9-12 and 14-20 were rejected over the combination of Kartheus and Dye, and further in view of Lowman. These rejections are respectfully traversed for the following reason.

As stated in the second paragraph of MPEP §706.02(j), "[t]o establish a *prima facie* case of obviousness, three criteria must be met." First, the rejection must indicate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. A review of the October 29, 2002 Action indicates that it fails to establish a proper *prima facie* showing of the obviousness of the differences between the claimed invention and the cited prior art references, alone or in the combinations asserted in the Action.

With regard to claim 1, it is respectfully urged that the §103 rejection was improper even before the claim was amended as set out above. The above amendments to claim 1 were not made to define over the combination of Kartheus and Dye; instead those amendments were made to (1) broaden the scope of the claim and (2) improve the form of the claim. The lack of a *prima facie* showing of the obviousness of the differences between that claim and the cited prior art references is made apparent by reference to the recitation in the third paragraph of claim 1 of a foot wrap that encompasses an inflatable bladder that is "disposed to apply pressure to the sole of a human foot." Neither of the cited references, alone or in combination, discloses or suggests such structure. Having established that the art does not teach all the elements of the claimed invention in accordance with MPEP §706.02(j), the next inquiry is whether either reference provides some

suggestion or motivation to modify the combined references in this manner. It is apparent upon review of page 2 of the Action that no attempt was made in the Action to identify such a suggestion or motivation. The Action does not even mention the position of the inflatable bladder, and certainly does not identify a suggestion or motivation to modify the references so as to position the bladder against the sole of the foot. Of course when there is no suggestion in the art to modify the references in this manner, there can be no showing of the third element of a *prima facie* obviousness rejection, namely, an expectation of success. In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed, and (3) some expectation that such a modification can be made successfully, the §103 rejection of this claim is improper and should be withdrawn.

Claims 8 and 13 were both amended as set out above to broaden the claim and to clarify the structure of the foot wrap and the manner in which it is applied to the human foot. Specifically, claims 8 and 13 were amended to clarify that when the wrap is secured to the foot, the inflatable bladder "acts against the sole of the foot." For the same reasons as set out above with respect to claim 1, a §103 rejection of these amended claims is improper. Neither of Kartheus nor Dye, alone or in combination, teaches this structure or the positioning of the bladder so that it acts against the sole of the foot. Nor was any attempt made in the Action to identify the required suggestion in these references that they should be modified to position the bladder so that it acts against the sole of the foot. Similarly, the Action makes no mention of why one skilled in the art would expect to be successful in making such a combination. It is therefore apparent that a proper *prima facie* showing of the obviousness of claims 8 and 13 has not been established, that a §103 rejection of claims 8 and 13 is improper, and that this rejection should be withdrawn.

The rejection of independent claim 17 over the combination of Kartheus, Dye, and Lowman is also traversed for failure to make out a proper *prima facie* showing of the obviousness of the differences between the claimed invention and the combined references. Considering first whether the cited references teach all the elements of the claimed invention, a review of the three references reveals that they do not teach first, second, and third tabs extending from the main portion of a foot wrap or that the third tab is "generally opposed to said first tab." Nor do these references disclose releasably securing the first and third tabs to the main portion "with the distal end of the first tab overlapping a distal end of said third tab" or that the dimensions of the first and third tabs are sufficient for the foot wrap to wrap around the arch of the foot with the first and third tabs overlapping, all as recited in claim 17. In an apparent attempt to find the required suggestion that the references should be combined, it is alleged in the Action that "[the wrap of]

Kartheus . . . can be configured to accommodate any specific application,” that “Lowman teaches an obvious equivalent alternative shape of the wrap,” and that “[i]t would have been obvious to one of ordinary skill in the art to further modify Kartheus to shape the wrap as taught by Lowman with a second tab generally perpendicular to the first tab for the specific application.” However, the Action does not state **why** one should make these specific modifications other than to suggest that it would have been obvious to do so. As stated at MPEP §2143.01,

“[a] statement that modifications of the prior to meet the claimed invention would have been ‘well within the ordinary skill of the art’ . . . because the references . . . teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references [citation omitted, underlining in original, bold emphasis added].”

In the absence of any such suggestion in the cited references, Applicant calls upon the Examiner to make such evidence of record (in the form of an affidavit as required by MPEP §2144.03) that such a modification and/or motivation is within the Examiner’s personal experience.

The next sentence (at the top of page 3 of the Action) states that “[t]he Lowman shape also reduces the amount of material used of only the arch is intended to be treated [sic],” but the meaning of this sentence is so unclear that it cannot be regarded as the required suggestion in the art of a motivation to combine the references in the manner asserted. Further, there is no recitation in claim 17 of “reducing the amount of material used” such that the relevance of this sentence is questionable. It is also noted, as it was in Applicant’s **Response to June 20, 2000 Office Action**, that Kartheus teaches away from a combination in which the outer fabric sheet is less extensible than the inner sheet. It is therefore respectfully suggested that it is unlikely that there would be any suggestion in the art that the cited references should be combined to make the claimed combination.

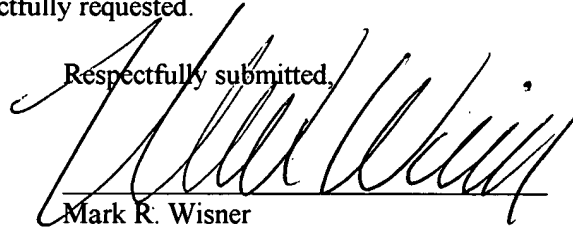
Finally, there does not even appear to be an attempt in paragraph (2) of the Action (spanning pages 2 and 3) to establish some likelihood of success in making the combination that is being asserted against claim 17 as required to establish a proper *prima facie* rejection. In short, because none of the three elements required to make out a proper *prima facie* rejection have not been established (the art does not teach all the elements, there is no suggestion to combine, and there is no expectation of success), it is respectfully urged that the obviousness rejection of claim 17 is improper and should be withdrawn.

The same remarks set out in the preceding paragraph are equally applicable to the §103 rejection of claim 20 and are re-asserted with respect to claim 20 as if fully set forth in this paragraph. Reconsideration and withdrawal of the rejection of claim 20 for this same reason is respectfully requested.

Because they are dependent on allowable independent claims, each of dependent claims 2-7, 9-12, 14-16, and 18-19 are likewise allowable. Reconsideration and withdrawal of the §103 rejections of these claims over the respective combinations of Kartheus and Dye, and Kartheus, Dye, and Lowman, asserted in the Action is respectfully requested.

Reconsideration and withdrawal of each of the rejections, entry of the above amended claims, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested.

Respectfully submitted,



Mark R. Wisner
Registration No. 30,603
Wisner & Associates
2925 Briarpark, Suite 930
Houston, TX 77042
Telephone: (713) 785-0555
Facsimile: (713) 785-0561

ATTORNEY FOR APPLICANT

Date: January 29, 2003